

REMARKS

By this Amendment, Applicant cancels claims 2, 10, 84, and 157, without prejudice or disclaimer. Claims 1, 3-9, 11-83, 85-108, 110, 112-116, 118-121, 123-128, 130-133, 135-156, 158-182, 184-192, 194-199, 201-204, and 206-214 are therefore currently pending. Pending claims 18-21, 52-59, 68, 69, 92-95, 124-128, 130, 131, 142, 143, 165-168, 195-199, 201, 202, 213, and 214 were previously withdrawn from consideration as allegedly being drawn to a nonelected species. As will be explained below, each of independent claims 1, 71, and 144, from which the withdrawn claims respectively depend, are allowable. Therefore, the withdrawn claims should be rejoined and also allowed.

By this Amendment, Applicant has amended claims 1, 3, 11, 12, 71, 85, 86, 144, 158, and 159 to clarify the claimed subject matter. No new matter has been introduced.

In the Office Action, the Examiner withdrew the previous bases for rejecting the claims, but set forth new grounds for rejection. In particular, the Examiner: rejected claims 1-9, 13-17, 36-42, 45, 47-51, 60-67, 70-83, 87-91, 110, 112-114, 119-121, 123, 132-141, 144-156, 160-164, 182, 184-186, 190-192, 194, 203, 204, and 206-212 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,860,348 to Doyle ("Doyle"); rejected claims 1, 4-17, 22-42, 45-51, 60-67, 70-91, 96-108, 110, 112-114, 118-121, 123, 132-133, and 135-141 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,594,835 to Gray ("Gray"); rejected claims 43, 44, 46, 115, 116, 118, 187, 188, and 189 under 35 U.S.C. § 103(a) as being unpatentable over Doyle in view of U.S. Patent No. 4,893,956 to Wojcik et al. ("Wojcik"); rejected claims 2, 3, 144-164,

169-182, 184-186, 189-194, 203, 204, and 206-212 under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of U.S. Patent No. 4,519,795 to Hitchcock, Jr. et al. ("Hitchcock"); and rejected claims 43, 44, 115, 116, 187, and 188 under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of Hitchcock.

As set forth above, the Examiner rejected various claims as anticipated by Doyle and/or Gray. Doyle discloses an applicator package for fluid products. The applicator package 10 of Doyle includes a housing 11 with a body portion 12 and handle portion 13. Doyle discloses a flexible impervious cover 16 such as a sheet of aluminum foil sealed across the open bottom of the housing 11 by a layer of adhesive 17 to form a chamber 15. A dauber 18 made from a sponge-like resilient material is mounted within chamber 15. The dauber is secured by means of a layer 19 of adhesive or cement at its upper end to the inside of the top surface of chamber 15. As shown in Fig. 3 of Doyle, when the cover foil 16 is in position, dauber 18 is held in a compressed state within the chamber 15. When cover 18 is peeled away from housing 11, dauber 18 extends into its expanded position, shown in Fig. 4. In the extended position, dauber 18, which is normally saturated with the product to be dispensed, can be used to apply the fluid product. (Col. 2, line 32 through col. 3, line 31.)

Gray discloses a sachet containing an impregnated substrate. The sachet comprises a top foil 1 which is a laminate of two films 2, 3, and a bottom foil 4 provided with a pocket 5. The top and bottom foils are sealed together through heat seals on a shoulder. An impregnated sponge 10 is located within the pocket 5 and held under compression by the top foil 1 and the base of pocket 5. A V-notch 11 is provided to

facilitate opening of the sachet and removal of the impregnated sponge 10. (Col. 3, lines 8-23.)

In the Office Action, the Examiner rejected claim 1 as being anticipated by both Doyle and Gray. Neither Doyle nor Gray discloses or suggests each and every aspect of amended claim 1. For example, neither Doyle nor Gray discloses or suggests the combination of a device for applying a product, including “a first portion defining a recess” and an “application member attached to the second portion.” Regarding Doyle, that reference does not disclose or suggest a first portion defining a recess. The alleged “first portion” of Doyle -- flexible impervious cover 16 -- is a flat piece of aluminum foil with no recess. There is simply no structure on the flexible impervious cover 16 of Doyle that meets the claimed recess limitation. Regarding Gray, that reference does not disclose or suggest an application member attached to the second portion. In Gray, the alleged “applicator member” is a sponge 10 that is removed completely from the foils during use. The sponge is not attached to either of the foils and is specifically configured to be removable from the foils when they are torn open. Because neither reference discloses or suggests the recited combination of elements, the rejections of independent claim 1 based on Doyle and Gray should be withdrawn.

Independent claims 71 and 144 also recite a device for applying a product. Neither Doyle nor Gray discloses or suggests each and every aspect of amended claims 71 and 144. For example, claims 71 and 144 recite the combination of a first portion defining a recess, the recess of the first portion and the second portion defining a substantially closed reservoir, and an application member attached to the second

portion. Neither Doyle nor Gray discloses or suggests such a combination, at least for reasons similar to those set forth above with respect to claim 1. For at least these reasons, the rejections of independent claims 71 and 144 based on Doyle and Gray should be withdrawn.

Independent claims 1, 71, and 144 are also allowable over the other cited references. In the Office Action, the Examiner rejected dependent claim 157 as being unpatentable over Gray in view of Hitchcock (U.S. Patent No. 4,519,795). By this Amendment, claim 157 has been canceled and the subject matter of claim 157 has been placed into independent claim 144. In the Office Action, the Examiner asserted that “[a]lthough the Gray reference does not disclose that the applicator member 10 is attached to the second portion 1, attention is directed to Hitchcock, Jr. et al reference, which discloses another application device comprising an application member 14, attached to an upper (second) portion by bonding.” The Examiner then concludes that “[t]herefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the applicator member 10 to the second (upper) portion 1 of the Gray device in view of the teaching of the Hitchcock, Jr. et al reference for preventing soiling the hand of the person and facilitating holding the applicator during use.” (Office Action, at 5.)

Hitchcock discloses a disposable swab for application of medicament to the skin. Referring to Figs. 1-4, the swab 10 comprises a flat sheet-like strip with a pad member 14 such as polyester sponge material secured by adhesive or heat sealing to a foil side 16 of the strip 12. Pad 14 may be impregnated with a medicament or the like.

(Col. 3, lines 19-27.) Pad member 14 is enclosed in a frangible pouch 32 which may be made of aluminum foil laminated to a thin plastic material of polyethylene or the like, and then preferably heat sealed at its edges 33 to strip 12, to completely enclose pad 14. A conventional tear tab 34 may be provided for easy manual tearing removal of frangible pouch 32 for exposure of pad 14. Thereafter, swab 10 may be used, transferring the medicament stored in pad 14 to the skin. (Col. 3, lines 51-59.)

The rejection based on Gray and Hitchcock should be withdrawn because it would not be obvious to modify the Gray device by attaching the sponge 10 to the top foil 1. Such a modification would be completely contrary to the purpose of the Gray invention, which is to provide a sponge which can be easily removed from the sachet. Such a combination therefore would not be obvious to one of ordinary skill in the art. Moreover, the Examiner has provided no explanation in the Office Action as to how the Gray reference would be modified, nor has the Examiner provided any explanation of the specific motivation or teaching in Hitchcock to modify the device of Gray. For at least these reasons, the independent claims, including claim 144, are allowable over the combination of Gray and Hitchcock.

Claims 3-9, 11-70, 72-83, 85-108, 110, 112-116, 118-121, 123-128, 130-133, 135-143, 145-156, 158-182, 184-192, 194-199, 201-204, and 206-214 depend either directly or ultimately from one of claims 1, 71, and 144, respectively, and therefore are patentable for at least the same reasons each of claims 1, 71, and 144 is allowable. In addition, at least some of these dependent claims recite unique features and

Customer No. 22,852
Application No. 10/060,234
Attorney Docket No. 05725.1017

combinations which are neither taught nor suggested by the cited art and therefore at least some also are separately patentable.

Applicant respectfully requests the withdrawal of the outstanding rejections, the rejoinder of the withdrawn claims, and the timely allowance of claims 1, 3-9, 11-83, 85-108, 110, 112-116, 118-121, 123-128, 130-133, 135-156, 158-182, 184-192, 194-199, 201-204, and 206-214.

The Office Action contains various characterizations and assertions regarding Applicant's claims and the cited art with which Applicant does not necessarily agree. To the extent Applicant has not specifically addressed those characterizations and assertions, Applicant declines to subscribe to the same.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 27, 2004

By:

Troy E. Grabow
Troy E. Grabow
Reg. No. 43,440